

REMARKS

In response to the Restriction Requirement of November 4, 2004, Applicants elect, with traverse, the invention shown in Claims 15-21, 23-33, drawn to voice cards with sound-producing means, classified in class 40, subclass 124.03, as discussed in teleconference with Examiner Chow on October 27, 2004. It is noted that Claim 22 is withdrawn from further consideration by the Examiner as being drawn to a non-elected claim. Applicant has also withdrawn Claim 29 from consideration.

Applicants would initially like to thank the examiner for the indication of allowable subject matter in Claims 31 - 33. In the Office Action, Claims 15-20, 23-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goetcheus et al (US Pat. No. 5,444,767) and in view of Ohara et al. (US Pat. No. 6,356,626). Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Goetcheus et al. in view of Ohara et al., and further in view of Johnson et al. (US Pat. No. 5,155,760). Claims 31-33 are objected to as being dependent upon a rejected base claim, but the Examiner has indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

It is requested that after the search, the Examiner reconsider this request for restriction and consider the remaining claims in the case. In the meantime, Applicant consents to cancellation of the non-elected claims all subject to the right to proceed with divisional applications.

Applicant has carefully reviewed the Office Action's grounds for denying patent protection to Claims 15 - 21 and 22 - 30, and respectfully request reconsideration of the claims as amended in view of the remarks presented below.

REJECTIONS UNDER 35 U.S.C. §103(A)

The disallowed claims all stand rejected under Section 103 as being obvious over the cited art. In order to establish a *prima facie* case of obviousness, the Office Action must set forth three findings:

"To establish a *prima facie* case of obviousness, three basic criteria must be met.

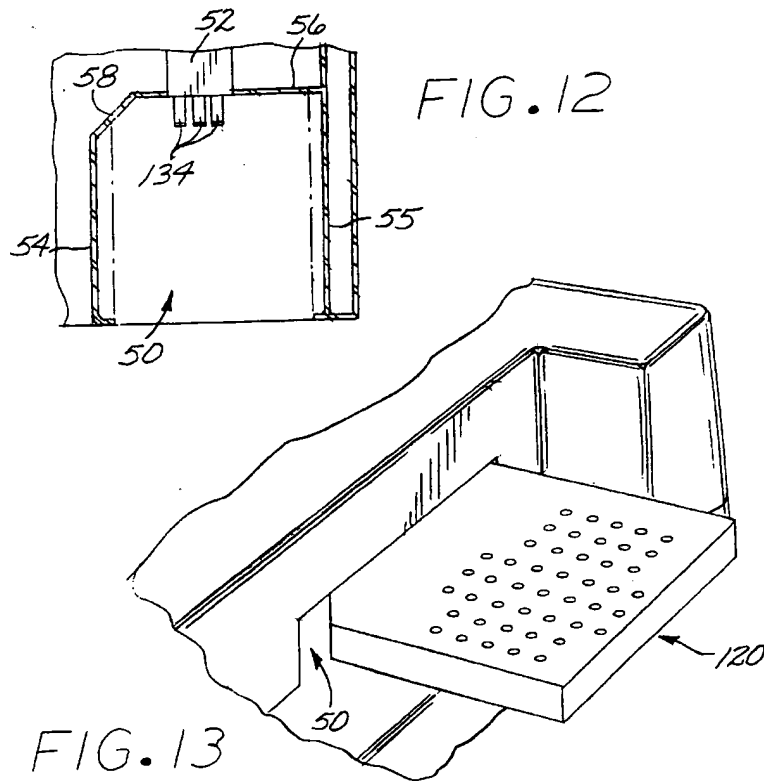
First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." MPEP §706.02(j).

From the foregoing, no claim can be rejected under §103 unless each of the criteria are established by the Office Action. Because the rejection of Claims 15 - 21 and 23 - 30 do not comply with these requirements as set forth below, the rejection of these claims are improper and cannot be sustained.

Claim 15

Claim 15 includes the limitation of a recorder-imprinter device "including a housing **with a port configured to complementally receive said voice module ...**" This is clearly shown in Figures 11 - 13 of the present application, and in particular Figures 12 and 13 reproduced below:



The port and complimentary voice module are positively recited limitations that are not taught nor suggested by the cited art. The complimentary nature of the voice module and port are discussed on page 27 of the present application:

"The interface port is further configured with side walls **54** and **55**, and end wall **56** and a diagonal wall **58**, or first indexer, between the end wall and the left side wall **54** so as to only complement the profile of the voice module when it is inserted in one way. Thus, as mentioned earlier, the configuration of the voice module, and particularly the diagonal wall **160** (Figs. 7 & 8), or second indexer, of the voice module's casing **150**, serves to orient and align the voice module in the interface port to insure proper mating and electrical contact between the port's female contact receptacle and the contact plates **134** of the voice module **120**."

The feature of the port on the recorder-imprinter device, and its complimentary characteristic with reference to the voice module, is neither addressed nor accounted for in the Office Action rejecting Claim 15. As such, the Office Action has failed to establish the criteria in the *prima facie* case of obviousness requiring that "the prior art reference (or references when combined) must teach or suggest **all** the claim limitations." Applicants respectfully submit that Claim 15 is allowable over the art of record.

Claim 15 has further been amended to recite the following step: *relaying the personal message in real time directly from a customer to said storage device of said recorder-imprinter*. As discussed at length in the specification, the process of conveying the voice message of the customer to the voice module is performed directly by recording the message at the recorder-imprinter device, either in person or over the telephone, without first storing the message at some distant central facility processing location. Applicant respectfully submits that Claim 15 as amended clearly distinguishes over the art of record.

Claim 16

Claim 16 has been amended to clarify the prompting step is verbally communicated across the telephone network using commands stored in the recorder-imprinter device. As

amended, Claim 16 clearly distinguishes over the LED light of Ohara, and the Office Action already conceded that Goetcheus fails to teach the recited prompting step. [Office Action, p. 5]. Accordingly, Applicants respectfully submit that Claim 16 as amended is patentably distinguishable over the art of record and is properly passed to allowance.

Claim 17

Claim 17 has been amended to depend from Claim 16, and further clarifies that the personal computer is located at the retail outlet to distinguish over the central processing center of Goetcheus. The computer interface has also been further clarified as a separate and distinct feature from the telephone port previously recited as part of the recorder-imprinter device. Applicants respectfully submit that Claim 17 as amended is patentably distinguishable over the art of record and is properly passed to allowance.

Claim 18

Claim 18 includes the feature whereby a telephone call from a remote location is placed over a conventional telephone network to a retail location, and in response to said telephone call transferring said telephone call to said personal computer. Applicant respectfully submits that the Office Action's assertion that Claim 18 is taught or suggested by Goetcheus et al. is incorrect. As clearly seen in Figure 1 of Goetcheus, the telephone call from the customer (remote location) is not placed to the retail location, but rather a central facility computer system. Thus, there can be no showing of a telephone call be transferred to a personal computer *in response to a telephone call to a retail location*. The Office Action fails to explain this obvious contradiction, and it is clear that the prior art does not teach the claimed combination of steps in Claim 18. As such, the Office Action has failed to establish the criteria in the *prima facie* case of obviousness requiring that "the prior art reference (or references when combined) must teach or suggest **all** the claim limitations." Applicants respectfully submit that Claim 18 is allowable over the art of record.

Claim 19

Claim 19 is dependent upon Claim 17, 16, and 15, each of which has been independently shown to be allowable over the prior art of record. Therefore, Claim 19 is in condition for allowance based on the arguments previously presented with respect to Claims 15 - 17.

Claim 20

The Office Action concedes that the step of "transferring said incoming call to said recorder-imprinter by pressing a selection button on said recorder-imprinter to cause said recorder-imprinter to automatically seize said incoming call" is not found in its primary reference (Goetcheus). The Office attempts to overcome the deficiency in Goetcheus by selecting an unrelated passage in Ohara. The Office Action then concludes that "it would have been obvious to one skilled in the art at the time the invention was made to modify Goetcheus et al and Ohara et al to have the "transferring ... incoming call" as taught by Ohara et al such that the modified system of Goetcheus et al and Ohara et al would be able to support the button to the system users." Applicants respectfully submit that the foregoing cannot satisfy the initial criteria of a §103 rejection requiring that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Here, the Office Action points to nothing more than an unsupported conclusion that it would have been obvious. The Federal Circuit has condemned such circuitous reasoning as completely ignoring the essential criteria of an obviousness rejection.

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes **evidence** relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. **The factual inquiry whether to combine references must be thorough and**

searching. It must be based on objective evidence of record." *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Applicants submit that there is no "evidence" of record relied upon to modify Goetcheus to incorporate a button for capturing a telephone call on the recorder-imprinter device, merely a bald conclusion by the Office Action that such would have been obvious. In failing to conduct a "thorough and searching" inquiry, and relying simply on unstated evidence, the Office Action fails to establish a *prima facie* case of obviousness. Further, Applicants submit that no suggestion can be found in the record because Goetcheus does not contemplate that the recorder-imprinter device will be used to receive calls remotely from customers but rather only from the central facility computer system. Because "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight," the rejection of Claim 20 is improper. *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000).

Claim 23

The arguments presented in connection with Claim 15 are incorporated herein by reference. Claim 23 also includes the step of "receiving a telephone call from a customer and connecting said telephone call with said recorder-imprinter to record said customer's personal message." It is respectfully submitted that the Office Action's assertion that the step is taught by Goetcheus et al. is incorrect, in that the customer telephone call is never connected to the recorder-imprinter device in the Goetcheus disclosure. Thus, there can be no *prima facie* case of obviousness and the rejection of Claim 23 is improper.

Claim 24

The remarks presented with respect to Claims 20 and 21 are applicable here and demonstrate that Claim 24 is not obvious over the cited art, and said remarks are incorporated herein by reference.

Claim 25

Claim 25 has been amended to clarify that the personal computer is local to the recorder-imprinter device and stores voice messages received by the recorder-imprinter device. Conversely, the central facility computer system of Goetcheus et al relied upon by the Office Action to establish the claimed feature does not store voice messages received by the recorder-imprinter device, but rather receives the voice messages from a telephone line as communicated by the customer. As such, the two systems are distinctly different and there is no teaching or suggestion in Goetcheus or any other cited reference to employ the personal computer step as claimed in Claim 25. As such, the Office Action cannot establish the criteria of a *prima facie* case of obviousness requiring that "the prior art reference (or references when combined) must teach or suggest **all** the claim limitations." Applicants respectfully submit that Claim 25 is allowable over the art of record.

Claim 26

Because the Office Action has identified the central facility computer system 12 in the Goetcheus et al reference as the "personal computer" limitation, Claim 26's recitation of "configuring said personal computer with a microphone for audible receipt of said personal message" where the user is located at the personal computer, is not taught nor suggested by the cited reference. In fact, Goetcheus teaches away from the claimed invention by using the store front playback device for the purpose recited in the personal computer feature of the present invention. Accordingly, there can be no teaching or suggestion that the claimed invention is disclosed in the cited reference.

Claim 27

Because the central facility computer system of Goetcheus is not located with the first recorder-imprinter at a first retail location, it is respectfully submitted that this Claim was improperly rejected under the teachings of Goetcheus and should be withdrawn.

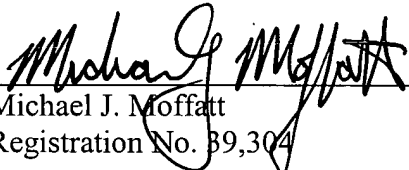
Claim 30

See Claim 26.

Applicants now respectfully submit that Claims 15 - 21, 23 - 28, and 30 - 33 are in condition for allowance, and early notification of same is earnestly solicited. If the examiner believes that a telephone conference will further the prosecution of this Application, the examiner is cordially invited to contact the undersigned at the number below.

Respectfully submitted,

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